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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,207	09/21/2005	Noriaki Yukawa	033036.086	8994

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EXAMINER
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MALEKZADEH, SEYED MASOUD

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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09/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,207	<b>Applicant(s)</b> YUKAWA ET AL.	
	<b>Examiner</b> SEYED M. MALEKZADEH	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of group I, claims 1-7 in the reply filed on 07/15/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the paying out operation" in the first line. There is insufficient antecedent basis for this limitation in the claim because prior to the cited limitation, the claim fails to clearly define "a paying-out operation" for the claimed carrier tape forming apparatus.

Claim 2 recites the limitation "the tape feeding operation" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim because prior to the cited limitation, the claim fails to clearly defines "a tape feeding operation" for the claimed carrier tape forming apparatus.

Claim 3 recites the limitation "the paying out operation" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim because prior to the cited limitation, the claim fails to clearly define "a paying-out operation" for the claimed carrier tape forming apparatus.

Claim 5 recites the limitation "the feeding amount of the tape" in the fourth line of the claim. There is insufficient antecedent basis for this limitation in the claim because prior to the cited limitation, the claim fails to clearly define "a feeding amount of the tape"

Claim 6 recites the limitation "the feeding amount adjusting portion" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim because prior to the cited limitation, the claim fails to clearly define "a feeding amount of the tape"

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanehara (JP 9-132207 A).

Art Unit: 1791

Kanehara (JP '207) teaches a machine for molding an embossed carrier tape of resin as a carrier tape forming apparatus comprising a base (2) in which a pivotally delivery reel (3A) as a pay-out reel winding of tape paying out unit is assembled on the base (2); furthermore, the apparatus include a first guidance (4b), a first tension grant roll (4c), and a second guidance roll (4d), all together, as a tape feeding unit for feeding the tape; moreover, the apparatus include a guiding slit part (4e), a heating apparatus (6), a hollow processing device (7) as a forming unit, a sending hole processing device (8) as a perforating unit, an intermittent driving part (5) with a holding stand (5a), a movable carriage (5b) and a first two clamp part (5c) and a second clamp part (5d) as a double-acting driving unit; also, a fixed clamp part (5e) as controller, moreover, a third guidance roll (4f), a second tension grant roll (4g), a fourth guidance roll (4h), and a take up reel (3B) with a driving shaft (4i) are considered as a tape taking-up unit wherein the double-acting driving units are provided as driving sources of the tape feeding unit and the forming unit (7) and the taking up unit (4f, 4g, and 4h) are fluid operated and movable along a straight path and the controller (5e) independently controls driving/stopping of the double acting driving units for the forming unit (7) and tape taking-up unit (4f, 4g, and 4h) in association with the driving/stopping of the double acting driving unit for the feeding unit (4b, 4c, 4d). (See abstract and paragraphs [0006] and [0028] - [0032]; figures 5-7)

Art Unit: 1791

Moreover, the prior art teaches the tape feeding unit includes a guiding slit part (4e) as a tape holding means movable back and forth in unison by the double-acting driving unit for the tape feeding unit and a stopper (5e) for restricting a position of the tape holding means to adjust the feeding amount of the tape. Furthermore, the prior art discloses the stopper (5e) includes forward most position determining portion, a rear most position determining portion and a feeding amount adjusting portion.

Also, Kanehara (JP '207) teaches the tape holding means (4e) includes at least one pair of tape holders (5c, 5d) are provided across the forming unit (7) and the perforating unit (8), and a connecting member (5b) for connecting the pair of tape holders together to be movable back and forth by the double-acting driving unit.

The prior art, thus, meets all the claim limitations and therefore, Kanehara (JP '207) anticipates the claims 1-2 and 5-7.

Claim 2, recites "wherein the paying-out operation by the tape paying-out unit is effected by the double-acting driving unit provided for the tape feeding unit for feeding the tape feeding operation"; moreover, claim 3, recites "a braking amount of the brake belt is adjusted for adjusting an amount of the tape to be paid out from the tape paying-out, in accordance with a movement of the dancer roller associated with the feeding portion of the tape feeding unit." (See lines 4-6) Also, claim 5 recites "for restricting a position of the tape holding means thereby to adjust the feeding amount of the tape." (See lines 3-4)

Art Unit: 1791

Moreover, claim 6 recites "the feeding amount of the tape being adjustable by the feeding amount adjusting portion." (See lines 3-4). All of these recitations are directed to the intended use of a carrier tape forming apparatus.

Intended use has been continuously held not to be germane to determining the patentability of the apparatus, *In re Finsterwalder*, 168 USPQ 530.

The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself, *In re Casey*, 152 USPQ 235,238.

Purpose to which apparatus is to be put and expression relating apparatus to contents thereof during intended operation are not significant in determining patentability of an apparatus claim, *Ex parte Thibault*, 164 USPQ 666.

A recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations, *EX parte Masham*, 2 USPQ2d 1647.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanehara (JP 9-132,207) in view of Larsen et al (US 5,389,190)

Kanehara (JP 9-132,207) teaches all the structural limitations of a carrier tape forming apparatus, as discussed above in rejection of claims 1-2 and 5-7; however, the prior art fails to teach the tape paying-out unit (3A) includes a dancer roller for adjusting a paying-out operation and a brake belt for braking a reel shaft (4a) of the pay-out reel.

In the analogous art, Larsen et al. (US 5,389,190) teaches an apparatus for applying a twist-tie to a multiple recloseable, flexible packaging container



Art Unit: 1791

including a payout mechanism for holding a supply of twist tie material; further, an extracting and cutting mechanism is configured to extract a continuous length of the twist-tie material from the supply of the twist-tie material and cut a twist tie of a desired length. (See abstract) Furthermore, Larsen et al. (US '190) teaches the payout mechanism (16) includes a dancer arm (46) pivotally secured as a first end (47) via a suitable fastener (48) to the secondary support frame (14), and a second end (49) of the dancer arm (46) includes a rotatable guide roller (50) over which the continuous length of twist-tie material (25) travels subsequent to passing over a guide pin (51) mounted on an extension arm (52) of the secondary support frame (14). (See lines 8-25, column 4) Also, Larsen et al. (US '190) teaches a brake mechanism (26) forming part of the payout assembly (16) includes pneumatic cylinder (28) having an extensible rod (30). A free end (32) of the extensible rod (30) is secured to a first end (34) of a brake band (36), as a bracket belt. The brake band (36) extends around the support shaft (20) where a second end (38) of the brake band (36) is fixed to the secondary support frame (14) by a clamp (40). (See lines 54-62, column 3)

Therefore, it would have been obvious for one of ordinary skill in the art at the time of applicant's invention to modify the carrier tape forming apparatus as taught by Kanehara (JP 9-132,207) through providing a dancer roller and a brake belt for braking a reel shaft of the pay-out reel of the tape paying-out unit in order to extract an efficient amount of tape from the paying-

Art Unit: 1791

out unit while minimizing the defects and scraps during operation of the apparatus, as suggested by Larsen et al. (US '190).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanehara (JP '207) in view of Teed (US 3,984,272)

Kanehara (JP '207) teaches all the structural limitations of a carrier tape forming apparatus, as discussed above in rejection of claims 1-2 and 5-7; however, the prior art fails to teach the apparatus further include a slitting unit for slitting or cutting off a width-wise end of the tape.

In the analogous art, Teed (US '272) teaches an apparatus for successively forming disposable diapers wherein the apparatus comprises a supplying and positioning unit, and also an embossing and securing unit wherein the apparatus comprises a cutting means cooperating with the positioning means to cut the elongate pads of fibers in which the cutting means comprises feed rolls (80 and 81) positioned on each side of the elongate continuous fibers in which, together, the feed rolls form a nip there-between for receiving and feeding there-through the elongate continuous fibers. Furthermore, the prior art teaches each of the rollers (80 and 81) include a cutting blade (82 and 83), respectively. Therefore, the prior art teaches a slitting unit for slitting or cutting off a width off a width-wise end of the continuous fibers.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of applicant's invention to modify the carrier tape forming apparatus as taught by Kanehara (JP 9-132,207) through providing a slitting or cutting unit in order to cut off a width-wise end of the tape in order to improve the apparatus by minimizing a cumbersome and tedious hand work for cutting the elongated tapes, as suggested by Teed (US '272)

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Masoud Malekzadeh whose telephone number is 571-272-6215. The examiner can normally be reached on Monday – Friday at 8:30 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin, can be reached on (571) 272-1189. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Art Unit: 1791

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9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. M./

Examiner, Art Unit 1791

/Eric Hug/

Primary Examiner, Art Unit 1791